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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,847	06/13/2005	Jun Sakamoto	IPE-052	1538

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EXAMINER

MESH, GENNADIY

ART UNIT	PAPER NUMBER
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1711

MAIL DATE	DELIVERY MODE
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06/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,847	Applicant(s) SAKAMOTO ET AL.	
	Examiner Gennadiy Mesh	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
 4a) Of the above claim(s) 20-52 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-19 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Claims 1-19 in the reply filed on April 16, 2007 is acknowledged.

Claims 20 –52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Inventions, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention: language of Claim 1 expresses number density as integer (100) divided by mass (0.02 mg) instead of volume – appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

1. Claims 1- 5, 8 – 11, 13-15 and 16 –18 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoyama et al.(US 6,365,659).

Regarding Claims 1- 5 and 17-18 Aoyama discloses polyester composition and films, including laminate (see lines 10 – 26,column 11) , comprising preferably from 3ppm to 50 ppm of titanium oxide (see lines 45-49,column 4 and), wherein particle may have equivalent circular diameter more than 1 micron(see line 36,column 3) and phosphorous in the preferable amount from 3ppm to 100 ppm. Titanium particles is used as a polymerization catalyst and can be present as complex oxide with silicon – (see lines 30 – 40,column 4).

Regarding Claims 5 and 8: Titanium compound can comprise alkoxy group – (see lines 1-5,column 5).

Regarding Claims 9-11 see lines 62-68,column 6 and 10 – 23,column 7.

Regarding Claim 13 see lines 3-9,column 7.

Regarding Claims 14 and 15 Aoyama discloses that composition can comprise alkaline earth metal, including magnesium, in preferable range of 10 ppm to 100 ppm see lines 19 – 30,column 6 and Table 1,Example 3.

Regarding Claim 16: as substantially same, composition disclosed by Aoyama - comprising same type and quantity of conductive particle will inherently has same volume receptivity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) as it applied to claims 1- 5, 8 – 11, 13-15 and 16 –18 above, and in view of Naylor et al.(WO 97/47675).

As it was discussed above Aoyama discloses that titanium oxide catalyst could have different structures(see lines 1-5, column 5) including alkoxy groups, but silent about specific groups as, for example, residue from hydroxycarboxylic acids as it claimed by Applicant in claims 6 and 7.

However, use of titanium catalysts prepared by reaction of the titanium as alkyl titanate with lactic or citric acids taught by Naylor et al (WO 97/47675) – see pges 11 and 12. Naylor teach that this type of titanium catalyst is preferable for production of film or bottle grades polyester resins, because it allowed produce resin with low haze value and good color, due to elimination of precipitation inorganic titanium compounds as titanium dioxide (see page 3,third paragraph).

Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use specific titanium catalyst per teaching of Naylor in order to obtain composition disclosed by Aoyama with better (low) haze and color (white) hue.

3. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) as it applied to claims 1- 5, 8 – 11, 13-15 and 16 –18 above, and in view of Kato et al.(US 6,680,353).

As it was discussed above Aoyama disclosed use of phosphorus based compounds, but silent about specific compound as ethyl diethylphosphonoacetate.

However, Kato teach that this specific compound is preferable in view of “the excellent effects of coloring prevention and melt stability” – see lines 23-45,column 8.

Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use ethyl diethylphosphonoacetate in polyester resin composition in order to obtain polymer with good color and melt stability.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.(US 6,365,659) as it applied to claims 1- 5, 8 – 11, 13-15 and 16 –18 above, and in view of Uchida et al.(US 6,670,030).

As it was discussed above Aoyama discloses use of the polyester composition for laminate films, but silent about magnetic recording laminated film.

However, polyester films routinely used for base layer of magnetic recording films. For example, Uchida discloses that biaxially oriented laminate polyester film can be used for recording medium due to excellent running durability(see abstract).

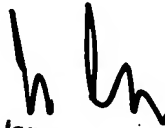
Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use polyester composition disclosed Aoyama for recording medium laminated film as it taught by Uchida.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gennadiy Mesh whose telephone number is (571) 272 2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


James J. Seidleck
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Gennadiy Mesh
Examiner
Art Unit 1711


05/23/07